IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

SUPPLEMENTAL APPEAL BRIEF

Inventors	:	Terry L. Oehrke
Serial No.	:	09/594,070
Filing Date	:	June 14, 2000
Title	:	COMPUTER NETWORK METHOD AND SYSTEM FOR GUARANTEED MESSAGING SERVICE
Group/Art Unit	:	2144
Examiner	:	Michael A. Delgado
Docket No.	:	1234

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provisions of 37 C.F.R. § 41.37(b)(2), Appellant submits this Supplemental Appeal Brief in response to the Office Action mailed on October 5, 2005.

This Supplemental Appeal Brief is in furtherance of the Notice of Appeal filed on October 13, 2004 and the subsequent Appeal Brief filed on December 13, 2004. Appellant hereby requests to reinstate the appeal.

Enclosed herewith is a Petition for Extension of Time in which to file a response to the Office Action, along with the requisite fee.

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The Director is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.

I.   REAL PARTY IN INTEREST

The real party in interest in the present appeal is the assignee, Sprint

Communications Company, L.P. The assignment was recorded at Reel 011258, Frame 0478 of

the U.S. Patent and Trademark Office records.

II.   RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III.   STATUS OF CLAIMS

Claims 1-19 are pending in the application. Claims 1-19 stand finally rejected as

follows: claims 1-4, 7-12 and 15-19 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No.

5,974,122 to Nelson *et al.*; and claims 5-6 and 13-14 stand rejected under 35 U.S.C. § 103 (a) as

being unpatentable over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No.

5,974,122 to Nelson *et al.*, and further in view of U.S. Patent No. 6,130,875 to Doshi *et al.* The

present appeal is directed to claims 1-19, which are reproduced in the Claims Appendix attached

hereto.

IV.   STATUS OF AMENDMENTS

In response to the final rejection set forth in the Office Action dated April 13,

2004, Appellant filed an Amendment and Response to Office Action on June 14, 2004 that

included a proposed amendment to claim 1 of the application. In the Advisory Action dated

October 8, 2004, the Examiner indicated that such amendment would not be entered for purposes of appeal.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to a method and computer network for providing a reliable messaging service on a computer network, such as that used for routing e-mail messages over the Internet, so that a message will not be lost when the messaging server (*i.e.*, the intended destination server for the message) becomes non-operational.

Independent claim 1 (and thus dependent claims 2-8) is directed to the method of the present invention and will be described with reference to FIGS. 1 and 2 of the application. In accordance with the method, a message is routed to a messaging server 14 on the network 10 (*i.e.*, the intended destination server for the message). When the message is undeliverable to the messaging server 14 (such as when the messaging server 14 is not operational), the message is provided to a relay server 16 on the network 10. Then, when the messaging server 14 is operational, the message is re-routed from the relay server 16 to the messaging server 14 so that the message may reach its intended destination. Preferably, if the messaging server 14 does not become operational after a predefined period of time has elapsed, or a predefined number of attempts have been made, another messaging server 18 is invoked to receive the message. The subject matter of claims 1-8 is described on page 6, line 12 to page 8, line 10 of the application.

Independent claim 9 (and thus dependent claims 10-19) is directed to the computer network of the present invention and will be described with reference to FIG. 1 of the application. The computer network 10 includes a Domain Name System (DNS) server 12, a messaging server 14, and a relay server 16 operably connected to the DNS server 12 and the

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messaging server 14. The DNS server 12 is operable to route a message to the messaging server 14 (*i.e.*, the intended destination server for the message). The DNS server 12 is also operable to provide the message to the relay server 16 when the messaging server 14 is inoperable such that the message is undeliverable to the messaging server 14. The relay server 16 is then operable to re-route the message from the relay server 16 to the messaging server 14 when the messaging server 14 is operational so that the message may reach its intended destination. Preferably, if the messaging server 14 does not become operational after a predefined period of time has elapsed, or a predefined number of attempts have been made, another messaging server 18 is invoked to receive the message. The subject matter of claims 9-19 is described on page 4, line 4 to page 6, line 11 of the application.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

1.   Whether claims 1-4, 7-12 and 15-19 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No. 5,974,122 to Nelson *et al.*; and

2.   Whether claims 5-6 and 13-14 are unpatentable under 35 U.S.C. §103 (a) as being obvious over U.S. Patent No. 6,438,583 to McDowell *et al.* in view of U.S. Patent No. 5,974,122 to Nelson *et al.*, in further view of U.S. Patent No. 6,130,875 to Doshi *et al.*

VII. ARGUMENT

A. Appellant's Claims are not Obvious Over McDowell in View of Nelson

The Examiner has rejected claims 1-4, 7-12 and 15-19 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,438,583 to McDowell *et al.* ("McDowell") in view of U.S. Patent No. 5,974,122 to Nelson *et al.* ("Nelson").

McDowell discloses a system that addresses the problems that occur when a user switches from a first Internet Service Provider (ISP) to a second ISP but continues to receive e-mail messages sent to the first ISP. In the McDowell system, an e-mail message sent to the first ISP is: (1) received by the first ISP; (2) identified as belonging to a former subscriber of the first ISP; and then (3) forwarded directly from the first ISP to the second ISP, or, forwarded from the first ISP to a re-route server which in turn forwards the message to the second ISP.[1] Thus, in the McDowell system, the e-mail message is successfully received by the first ISP before it is forwarded to the second ISP (either directly or via the re-route server).

Nelson discloses a system and method for delivery of a facsimile to an intended destination when that destination is initially unavailable. In the system of Nelson, a facsimile message transmission is first attempted by initiating a telephone call from a first fax machine to an intended destination second fax machine. If the second fax machine is available and answers the telephone call, the facsimile message is transmitted to the second fax machine. However, if the second fax machine is not available (*i.e.*, busy or no answer), the facsimile message is routed to, and stored on, a messaging platform. The messaging platform, according to a predetermined schedule, makes subsequent calls to the second fax machine. If the second fax machine answers,

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[1] *See* McDowell at column 3, line 64 to column 7, line 49; column 8, line 14 to column 13, line 41.

the facsimile message is delivered from the messaging system to the second fax machine. If the

second fax machine is busy or does not answer, the messaging platform stores the message and

re-attempts delivery at a later time according to the predetermined schedule. If transmission of

the facsimile message to the second fax machine is still unsuccessful after several re-attempts, a

message is sent back to the originator of the facsimile message, informing them that delivery

could not be accomplished [2]

1.   Claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18, and 19

Appellant respectfully submits that a *prima facie* case of obviousness for rejecting

claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18, and 19 has not been established in that McDowell and

Nelson do not alone or in combination disclose or suggest the claimed invention. *See In re Bell*,

26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting *In re Rinehart*, 189 U.S.P.Q. 143,147

(C.C.P.A. 1976)) (finding that the Patent Office's burden of establishing a *prima facie* case of

obviousness is not met unless "the teachings from the prior art itself would appear to have

suggested the claimed subject matter to a person of ordinary skill in the art.").

a. No "another messaging server" Disclosed or Suggested in References

<u>Claims 2, 3, 4, 6, and 8</u>

Claims 2, 3, 4, 6, and 8 of the present application require, *inter alia*: (1) routing a

message to a messaging server, (2) providing the message to a relay server when the message is

undeliverable to the messaging server, (3) re-routing the message from the relay server to the

messaging server when operational, and (4) <u>invoking another messaging server</u> when the

message is undeliverable to the first messaging server.

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[2] *See* Nelson at column 3, line 6 to column 6, line 26

With respect to limitations (2) and (3) above, namely, <u>providing the message to a relay server when the message is undeliverable to the messaging server</u>, and <u>re-routing the message from the relay server to the messaging server when operational</u>, McDowell does not teach, suggest, or disclose any relay server or any detection of the messaging server's operability. Thus, there is no disclosure in McDowell of routing the message to a relay server when the messaging server is not operational and rerouting the message from the relay server to the messaging server when operational, as required in claims 2, 3, 4, 6, and 8 of the present application.

Furthermore, with respect to limitation (4) above, there is no teaching, suggestion, or disclosure in McDowell of <u>invoking another messaging server when the message is undeliverable to the first messaging server</u>. As discussed above, McDowell discloses only a system that routes an e-mail message to a first ISP and then forwards the message <u>from the first ISP to a second ISP</u> (either directly or via a re-route server). The McDowell system does <u>not</u>, however, disclose any system or method for <u>invoking another messaging server</u> when the message is undeliverable to the original messaging server, as required in claims 2, 3, 4, 6, and 8 of the present application.

As described in the present application, if messaging server 14 is still unavailable after exceeding a threshold amount of time or number of contact attempts, a processor in the system <u>invokes another messaging server 18</u> having the same name and IP address of the original server and routes the message to the newly invoked messaging server (*see* page 7, lines 20-29 of original application). Thus, if messaging server 14 <u>never</u> becomes available, the system of the present application provides a way for the message to be delivered to <u>another messaging server</u>.

By contrast, the system of McDowell has absolutely no provision for the case where the intended server is not available at the time the email is originally sent, much less for the case where the server is unavailable for an extended period of time. McDowell teaches a system for forwarding an e-mail message from a first ISP to a second ISP when a user switches from the first ISP to the second ISP. If the first ISP of the McDowell system were not operational, it would not be able to receive an e-mail message and, thus, would not be able to identify the intended recipient of the message as a former subscriber and thus would not be able to forward the message to the second ISP. Unlike the system of the present application, the McDowell system would simply lose the e-mail message sent to the inoperable first ISP such that the message would be undeliverable to the intended recipient. There is no teaching, suggestion or disclosure in McDowell of invoking another messaging server, as required in claims 2, 3, 4, 6, and 8 of the present application.

Similarly, Nelson does not teach, suggest, or disclose at least limitation (4) above, namely, invoking another messaging server when the message is undeliverable to the messaging server. As discussed above, Nelson discloses a system and method for delivery of a facsimile to an intended destination by storing and repeatedly re-attempting transmission of the facsimile to the destination. In Nelson, however, if a destination is repeatedly busy or does not answer, an Analyze Route Message is returned to the originating number, indicating that the intended destination was not available (see Nelson, column 5, lines 30-41). Thus, unlike the system of the present application, there is no teaching, suggestion, or disclosure in Nelson of invoking another messaging server to allow delivery of the message when the original messaging server is not available beyond a threshold time or number of attempts.

Neither McDowell nor Nelson, nor their combination, teach, suggest or disclose "invoking another messaging server" as required in claims 2, 3, 4, 6, and 8 of the present application. Thus, for at least this reason, claims 2, 3, 4, 6, and 8 are not obvious in view of McDowell, Nelson, or their combination, and the examiner's rejection should be overturned.

<u>Claims 10, 11, 12, 14, 16, 18 and 19</u>

Claims 10, 11, 12, 14, 16, 18 and 19 of the present application require, *inter alia*: (1) a messaging server, (2) a DNS server operable to route a message to the messaging server, (3) a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server, wherein the relay server is operable to re-route the message from the relay server to the messaging server when operational, and (4) <u>another messaging server</u> invoked by the relay server when the original messaging server is inoperable such that the message is undeliverable to the original messaging server in response to the re-routing.

As discussed above with respect to claims 2, 3, 4, 6, and 8, neither McDowell nor Nelson, nor their combination, teach, suggest or disclose "another messaging server" as required in claims 10, 11, 12, 14, 16, 18 and 19 of the present application. Thus, for at least this reason, claims 10, 11, 12, 14, 16, 18 and 19 are not obvious in view of McDowell, Nelson, or their combination, and the examiner's rejection should be overturned.

b. No Suggestion to Combine

It is well-established that the mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art <u>also suggests the desirability</u> of the combination. *In re Mills,* 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2403.1.

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In addition, although a prior art device may be capable of being modified, there must be a suggestion or motivation in the reference to do so. *Id.*

Here, the present invention is directed to a method and computer network for providing a reliable messaging service on a computer network, so that a message will not be lost when the intended destination messaging server becomes non-operational. The system claimed by the present application provides numerous alternatives for ensuring that a message will be delivered, even in the case of a non-operational messaging server.

McDowell, by contrast, is directed to a system for forwarding an email message sent to a first ISP to a second ISP so as to accommodate, for example, an email message sent to a user's first ISP email address when the user has already switched to a second ISP. McDowell discloses a system where the email message is received at the first ISP, recognized as belonging to the particular user, and then forwarded to the user's new second ISP. McDowell, however, does not address the problem addressed by the claimed invention of the present application, namely, what happens when the first ISP is not operational. McDowell makes absolutely no provisions for such a scenario, and presumably the message would simply be lost.

Nelson, on the other hand, is directed to a method of delivering facsimile messages from an originating first fax machine to an intended destination second fax machine. In the system of Nelson, when the second fax machine reports that it is busy, or does not answer, the facsimile message is stored. At a later time, according to a predetermined schedule, transmission of the facsimile to the second fax machine is re-attempted. If transmission of the facsimile message to the second fax machine is still unsuccessful, a message is sent back to the originator of the facsimile message, informing them that delivery could not be accomplished.

Thus, McDowell addresses the problem of a user changing ISPs by forwarding a message sent to the user's old email address on to the users' new email address. Nelson addresses the problem of delivering a fax to an intended second fax machine by repeatedly attempting to re-send the fax to that second machine until such time as the fax is received, or an error message is returned to the sender informing them that the second fax machine is not available. Neither, however, teach, suggest, or disclose the problem solved by the claimed invention of the present application, namely, how to reliably deliver a message over a computer network when the intended destination messaging server is not operational. Thus, one skilled in the art attempting to solve the problem contemplated by the claimed invention would not look to either McDowell or Nelson, nor is there any suggestion in either that would lead one to combine the two references.

Absent such a suggestion in the references, the examiner's rejection of claims 2, 3, 4, 6, 8, 10, 11, 12, 14, 16, 18, and 19 on this basis is unsupported by the art, and for this additional reason, should be overturned.

2. Claims 1, 5, 7, 9, 13, 15, and 17

Appellant respectfully submits that a *prima facie* case of obviousness for rejecting claims 1, 5, 7, 9, 13, 15, and 17 has not been established in that McDowell and Nelson do not alone or in combination disclose or suggest the claimed invention. *See In re Bell*, 26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting *In re Rinehart*, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976)) (finding that the Patent Office's burden of establishing a *prima facie* case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.").

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a. No Suggestion to Combine

As discussed in section VII(A)(1)(b) above, it is well-established that the mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art <u>also suggests the desirability</u> of the combination.

The invention claimed in the present application is directed to a method and computer network for providing a reliable messaging service on a computer network, so that a message will not be lost when the intended destination messaging server becomes <u>non-operational</u>. McDowell, by contrast, is directed to a system for forwarding an email message sent to a first ISP to a second ISP. Nelson is directed to a method of delivering facsimile messages from a first fax machine to a second fax machine, and returning an error message to the first fax machine if delivery cannot be accomplished. Neither McDowell nor Nelson, either individually or in combination, teach, suggest, or disclose the invention claimed in the present application, nor do they even contemplate the same problem solved by the claimed invention. As discussed above in section VII (A)(1)(b), absent any such suggestion to combine in either McDowell or Nelson, the examiner's rejection of claims 1, 5, 7, 9, 13, 15 and 17 on this basis is unsupported by the art, and should be overturned.

B.   Appellant's Claims are not Obvious Over McDowell in View of Nelson and Doshi

1.   Claims 5-6 and 13-14

The Examiner has also rejected dependent claims 5-6 and 13-14 under 35 U.S.C. § 103(a) as being obvious over McDowell in view of Nelson, in further view of U.S. Patent No. 6,130,875 to Doshi *et al.* ("Doshi"). Dependent claims 5-6 and 13-14 incorporate all of the limitations of independent claims 1 and 9, respectively, from which they depend. Thus, for the

reasons discussed above with respect to independent claims 1 and 9, Appellant respectfully submits that the examiner's rejection of dependent claims 5-6 and 13-14 should be overturned.

VIII. CLAIMS APPENDIX

See Claims Appendix (Pending Claims) attached hereto.

IX.   EVIDENCE APPENDIX

None.

X.   RELATED PROCEEDINGS APPENDIX

None.

Respectfully submitted,

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CLAIMS APPENDIX

1.   A method for providing a messaging service on a computer network, the method

comprising the steps of:

(a)   routing a message to a messaging server;

(b)   providing the message to a relay server when the message is undeliverable

to the messaging server; and

(c)   re-routing the message from the relay server to the messaging server when

operational.

2.   The method of Claim 1 further comprising:

(d)   invoking another messaging server when the message is undeliverable to

the messaging server in step (c).

3.   The method of Claim 2 further comprising:

(e)   routing the message to the other messaging server of step (d).

4.   The method of Claim 3:

further comprising (f) storing the message; and

wherein step (e) comprises changing server information of the stored message.

5.   The method of Claim 1 wherein step (c) comprises periodically attempting

delivery of the message from the relay server to the messaging server.

6.   The method of Claim 5 further comprising:

(d)   invoking another messaging server when the message is undeliverable to the messaging server in step (c).

7.   The method of Claim 1 further comprising:

(d)   sending the message to the messaging server in response to step (c).

8.   The method of Claim 3 further comprising:

(f)   sending the message to the other messaging server in response to step (e).

9.   A computer network for providing a messaging service, the network comprising:

a messaging server;

a DNS server operable to route a message to the messaging server; and

a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server;

wherein the relay server is operable to re-route the message from the relay server to the messaging server when operational.

10.   The network of Claim 9 further comprising:

another messaging server, the other messaging server invoked by the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to the re-routing.

11.   The network of Claim 10 wherein the relay server is operable to route the message to the other messaging server.

12.   The network of Claim 11 further comprising:

a storage device operably connected to the relay server and the other messaging server, the message being stored in the storage device; and

wherein the relay server is operable to change server information of the stored message to route the message to the other messaging server.

13.   The network of Claim 9 wherein the relay server is operable to periodically attempt delivery of the message from the relay server to the messaging server.

14.   The network of Claim 13 wherein the relay server is operable to invoke a process to create another messaging server when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to the re-routing.

15.   The network of Claim 9 wherein the relay server is operable to send the message to the messaging server in response to the re-routing.

16.   The network of Claim 11 wherein the relay server is operable to send the message to the other messaging server in response to routing the message to the other messaging server.

17.   The network of Claim 9 wherein the messaging server and the relay server are within a first data center.

18.   The network of Claim 10 wherein the messaging server and the other messaging server are in first and second data centers, the first data center remote from the second data center.

19.   The network of Claim 9 wherein the relay server is operable to invoke a process to create another messaging server with a same name and IP address.